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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,021	12/09/2003	Andreas Obrebski	0902-009	2756

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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EK

Office Action Summary

Application No.

10/730,021

Applicant(s)

OBREBSKI ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. *Claims 1-12, drawn to a microscope having a light guiding system with specific features related to the type of light sources being used and a stand having plural arms for supporting the microscope, classified in class 359, subclass 385.*
 - II. *Claims 13-34, drawn to a microscope having a power supply/data transmission system with specific features related to the structure of the power supply/data transmission system and a stand for supporting a microscope, classified in class 359, subclass 368.*

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility for a microscope with a light guising system without the specific features related to a power supply or data transmission system as defined in the invention II. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. If the invention I, claims 1-12, is elected then the following restriction on the basis of species is applied.

Claim 2 is generic to a plurality of disclosed patentably distinct species comprising the following species:

Species (I-A) directs to the use of a light emitter having an organic light generating device. This species is readable in claim 3;

Species (I-B) directs to the use of a light emitter having an electrochemical cell. This species is readable in claims 4-6;

Species (I-C) directs to the use of a light emitter having semiconductor devices. This species is readable in claims 7-9; and

Species (I-D) directs to the use of a light emitter having photoelectric cell. This species is readable in claims 10-12.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. If the Invention II, claims 13-34, is elected then the following restriction is applied.

II-A. Invention (II-A) directs to a microscope having a power supply with specific features related to the structure of the power supply and a stand for supporting a microscope. This invention is readable in claims 13-20.

II-B. Invention (II-B) directs to a microscope having a data transmission system with specific features related to the structure of the data transmission system and a stand for supporting a microscope. This invention is readable in claims 21-33.

II-C. Invention (II-C) directs to a microscope having a power supply and a data transmission system with specific features related to the structure of the power supply and the data transmission system and a stand for supporting a microscope. This invention is readable in claim 34.

The three mentioned inventions (II-A)-(II-C) are classified in class 359, subclass 368; however, each invention would require different field of searches related to the specific features recited in each invention. In particular, invention II-A would require searches in class 330 and class 250 for specific features related to the power supply while invention II-B would require searches in class 345 and class 358 for specific features related to data (de)modulator and display.

6. Inventions (II-C) and ((II-A), (II-B)) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the

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microscope having a power supply without a data transmission system as recited in claims 17-20 of the invention (II-A) is evidence to show that the microscope of the invention (II-C) does not need the particular details of the data transmission system as defined in claims 21-33 of the invention (II-B) for patentability and vice versa. The subcombination has separate utility for use in a microscope without the particular details of the other subcombination. In particular, a microscope with a power supply of the subcombination (II-A) does not need the specific features related to the data transmission system, the data acquisition unit and data display system as defined in the subcombination (II-B).

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. **If the Invention II-A, claims 13-20, is elected then the following restriction on the basis of species is applied.**

Species (II-A-1) directs to the use of a power supply having electrically insulated twisted pair of wires which are attached to the arms of the stand. This species is readable in claim 13;

Species (II-A-2) directs to the use of a power supply having an AC generator, an induction transmitter, and an induction receiver which are attached to the arms of the stand. This species is readable in claim 14;

Species (II-A-3) directs to the use of a power supply having a contact rail and a sliding contact disposed on the arms of the stand. This species is readable in claim 15;

Species (II-A-4) directs to the use of a combination of a device powered by electrical current, a power supply device, and a mechanically supporting component of the stand to form a current path between the two mentioned devices. This species is readable in claim 16;

Species (II-A-5) directs to the use of a power supply having a radiation emitter disposed at a distance from the microscope and a radiation receiver disposed on the microscope. This species is readable in claims 17-19; and

Species (II-A-6) directs to the use of a directs to the use of a combination of a device powered by electrical current, a power supply device, an inductive transmitter and an induction receiver disposed on the base of the stand of the microscope. This species is readable in claim 20.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. If the species (II-B), claims 21-33, is elected then the following restriction on the basis of species is applied.

Species (II-B-1) directs to the use of a data transmission system having electrically insulated twisted pair of wires which are attached to the arms of the stand. This species is readable in claim 21;

Species (II-B-2) directs to the use of a data transmission system having a transmitter, a data modulator, a receiver and a data demodulator. This species is readable in claims 22-25 and 32;

Species (II-B-3) directs to the use of a data transmission system having a contact rail and a sliding contact disposed on the arms of the stand. This species is readable in claim 26;

Species (II-B-4) directs to the use of a mechanically supporting component of the stand to form a current path between the data acquisition unit and the data display unit. This species is readable in claims 27-29;

Species (II-B-5) directs to the use of a data transmission system having a waveguide arrangement for guiding electromagnetic waves. This species is readable in claim 30.

Species (II-B-6) directs to the use of a data transmission system having optocoupler between two arms of the stand. This species is readable in claims 31 and 33.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. A telephone call was made to Krishna Kalidindi on 4/22/2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

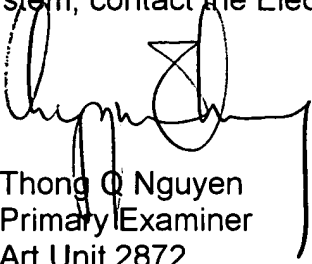
Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen
Primary Examiner
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